

**Remarks**

Claims 1-7, 9 and 10 are currently pending in this application. Claim 8 is cancelled in this amendment. Claim 1 is amended to state that the encapsulated food particle is a solid food particle. Support for this amendment can be found, *inter alia*, in the Abstract. Claim 1 at (a) is amended to state that the liquid encapsulating material comprises a sweetening agent, a food flavoring agent or enhancer, a food color, a food aroma agent, an anti-caking agent, a humectant, an antimicrobial agent, an antioxidant, a surface modifying agent, a moisture barrier, a shelf-life extending agent, a flavor retaining agent, a nutritional supplementing agent, a carbohydrate, a protein, a lipid, or a mineral. Support for this amendment can be found in canceled claim 8. Claims 1-7 and 10 are amended to state that the encapsulated food particle is a solid food particle. Support for this amendment can be found, *inter alia*, in the Abstract.

**Rejection Under 35 §USC 102(b)**

Claims 1-2 and 9 were rejected under 3 5 §USC 102(b) as being anticipated by Schurr (WO 97/07879).

Schurr is directed to encapsulating a solid particle, but not a solid food particle as cited in the claims.

Further, the teaching in Schurr of the coating composition is limited to those coating that appear in Examples 1-4. In Example 1, the coating is a GMA co-polymer of glycidyl methacrylate, butyl methacrylate, methyl methacrylate and styrene. In Example 2, the coating is wood rosin. In Example 3, the coating is either wax or rosin. In Example 4, the coating is stearic acid. None of the Schurr coating compositions have ever been claimed in the present application. Present claim 8 is not rejected under Schurr. Further, present claim 1 is amended by incorporating the language of claim 8 to state that the liquid encapsulating material (coating material) comprises a sweetening agent, a food flavoring agent or enhancer, a food color, a food aroma agent, an anti-caking agent, a humectant, an antimicrobial agent, an antioxidant, a surface modifying agent, a moisture barrier, a shelf-life extending agent, a flavor retaining agent, a nutritional supplementing agent, a carbohydrate, a protein, a lipid, or a mineral. None of these encapsulating materials is taught in Schurr.

As stated in M.P.E.P. §2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art

reference. Since Schurr does not teach the present encapsulating materials, Schurr fails to disclose each and every limitation of the present claims 1-7, 9, and 10, as amended. As such, claims 1-7, 9, and 10 are novel over Schurr. Reconsideration and withdrawal of this ground of rejection is respectfully requested.

#### **Rejection Under 35 §USC 103**

Claims 1-5 and 8-10 were rejected under 35 §USC 103(a) as being unpatentable over Schurr (WO 97/07879) in view of Johnson et al. (US Patent No. 3,949,094).

Schurr is discussed above. Johnson et al. are directed to a process for treating condiments. It is noted in col 2 lines 8-10 that the condiment is liquefied before encapsulation. In the present claims, as amended, the food particle that is encapsulated is a solid food particle. Schurr does not teach solid food particles and Johnson et al. teach non-solids (liquids). One would not look to Johnson et al. for the deficiency of solid food particles of Schurr when Johnson et al. teach a food particle (condiment) that must be liquefied before encapsulating.

In order for the Office to show a *prima facie* case of obviousness, M.P.E.P. §2143 requires that the Office must meet three criteria: (1) the prior art reference must teach or suggest all of the claim limitations; (2) there must be some suggestion or motivation, either in the reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and (3) there must be some reasonable expectation of success. The Office has clearly failed to meet its burden under (1), (2), and (3) above, since the teachings of Schurr in combination with Johnson et al. fail to teach or suggest all of the claim limitations of the present claims 1-7, 9, and 10, as amended. Reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 1, 6, 9, and 10 were rejected under 35 §USC 103(a) as being unpatentable over Schurr (WO 97/07879) in view of Brenner et al. (US Patent No. 3,971,852).

Schurr is discussed above. Brenner et al. are directed to a process for encapsulating an oil. The present claims, as amended, solid food particles that are encapsulated. Schurr does not teach solid food particles and Brenner et al. teach oils, which are non-solids. One would not look to Brenner et al. for the deficiency of solid food particles of Schurr when Brenner et al. teach encapsulating an oil, a non-solid.

Present claim 8 is not rejected under either Schurr or Brenner et al. Further, present claim 1 is amended by incorporating the language of claim 8 to state that the liquid encapsulating material (coating material) comprises a sweetening agent, a food flavoring agent or enhancer, a food color, a food aroma agent, an anti-caking agent, a humectant, an antimicrobial agent, an antioxidant, a surface modifying agent, a moisture barrier, a shelf-life extending agent, a flavor retaining agent, a nutritional supplementing agent, a carbohydrate, a protein, a lipid, or a mineral. None of these encapsulating materials is taught in either Schurr or Brenner et al.

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Claims 1, 7, 9, and 10 were rejected under 35 §USC 103(a) as being unpatentable over Schurr (WO 97/07879) in view of Swisher (US Patent No. 2,809,895).

Schurr is discussed above. Swisher is directed to the emulsification of an orange oil with corn syrup or corn syrup solids. The emulsion is extruded to form solid particles.

Present claim 8 is not rejected under either Schurr or Swisher. Further, present claim 1 is amended by incorporating the language of claim 8 to state that the liquid encapsulating material (coating material) comprises a sweetening agent, a food flavoring agent or enhancer, a food color, a food aroma agent, an anti-caking agent, a humectant, an antimicrobial agent, an antioxidant, a surface modifying agent, a moisture barrier, a shelf-life extending agent, a flavor retaining agent, a nutritional supplementing agent, a carbohydrate, a protein, a lipid, or a mineral. None of these encapsulating materials is taught in either Schurr or Swisher

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reference itself or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, and (3) there must be some reasonable expectation of success. The Office has clearly failed to meet its burden under (1), (2), and (3) above, since the teachings of Schurr in combination with Swisher fail to teach or suggest all of the claim limitations of the present claims 1-7, 9, and 10, as amended. Reconsideration and withdrawal of this ground of rejection is respectfully requested.

**Double Patenting**

Claims 1, 8, and 9 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-10 of US 7,163,708. Submitted herewith is a terminal disclaimer in compliance with 37 CFR 1.321(c). Reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 1-5 and 8-10 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 5, 7, and 10-12 of copending Application No. 10/523,225. Submitted herewith is a terminal disclaimer in compliance with 37 CFR 1.321(c). Reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 1, 3-5, and 8-10 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of copending Application No. 10/521,002. Submitted herewith is a terminal disclaimer in compliance with 37 CFR 1.321(c). Reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 1-2 and 8-10 were provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 13-16 of copending Application No. 10/524,673. Submitted herewith is a terminal disclaimer in compliance with 37 CFR 1.321(c). Reconsideration and withdrawal of this ground of rejection is respectfully requested.

For the foregoing reasons, it is submitted that the present claims are in condition for allowance. The foregoing remarks are believed to be a full and complete response to the outstanding office action. Therefore favorable reconsideration and allowance are respectfully requested. If for any reason the Examiner believes a telephone conference would expedite the prosecution of this application, it is respectfully requested that the Examiner call Applicants' representative at 314.659.3218.

If any additional fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 50-0421.

Respectfully submitted,  
SOLAE, LLC

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